REMARKS

Reconsideration of this Application is respectfully requested. In response to the Office Action ("Action") mailed August 4, 2006, Applicants submit the following remarks. Claims 1-35 are pending. Applicants respectfully request that the Office reconsider and withdraw all outstanding rejections.

I.   NOTICE OF ALLOWABLE SUBJECT MATTER

On page 5, the Action indicates that claims 6, 7, 22, and 23 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants wish to thank Examiner Raymond for the indication of allowable subject matter in the claims. At this time, Applicants have not amended the claims as suggested as it is earnestly believed that the pending claims already define patentable subject matter for the reasons set forth below.

II.   REJECTIONS UNDER 35 U.S.C. § 102

On pages 2-5, the Action rejects claims 1-5, 8-21, and 24-35 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent App. Pub. No. 2004/0102923 to Tracy et al. (hereinafter "Tracy"). Applicants respectfully traverse this rejection. For at least the following reasons, the Tracy does not anticipate these claims.

A.   TRACY DOES NOT QUALIFY AS PRIOR ART UNDER 35 U.S.C. § 102(b)

35 U.S.C. § 102 states:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior the date of application for patent in the United States
(Emphasis added.)

The instant application was filed on March 31, 2004. Tracy was published on May 27, 2004, which is after Applicant's filing date. Thus, Tracy was not printed publication more than one year prior the date of application for patent in the United States. Accordingly, 35 U.S.C. §

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102(b) does not apply and Applicants respectfully request that the rejection of the claims be withdrawn. Further, in an attempt to expedite prosecution, Applicants submit the following remarks discussing how Tracy does not anticipate the pending claims.

B. TRACY DOES NOT ANTICIPATE CLAIM 1 UNDER 35 U.S.C. § 102

The Action rejects claim 1 under 35 U.S.C. § 102 as allegedly being anticipated by Tracy. Applicants respectfully traverse this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claim 1 recites:

> A method of testing comprising:
> defining a process to be tested;
> identifying a plurality of risks associated with the process;
> quantifying each of the risks with a risk value;
> defining a test plan for the process, the test plan including a number of test cases, wherein testing of the test cases is prioritized based on the risk value; and
> executing the test plan.
> (Emphasis added.)

Tracy discloses a system of providing a risk assessment of a target system. See Tracy, Abstract. FIG. 1 of Tracy depicts a high level flow diagram 100 for the system. In 100, "information is gathered pertaining to the system or network undergoing" certification and accreditation. See Tracy, ¶0063. In 102, "a list of standards and/or regulations (or portions thereof) that the system must, or should, comply with" are selected. See Tracy, ¶0066. In 104, the system can select a set of test procedures (against which the system can be tested). See Tracy, ¶0067. In 106, the user can (continue to) add, delete and/or edit requirements selected at step 102 and/or test procedures selected at step 104. See Tracy, ¶0068. In 108, upon completion of testing, the risk assessment step involves assessing for each requirement failure (should any exist) the vulnerability of the system, as well as the level of the threat as determined by the information gathered, and the risk assessment 108 provides as output an estimate of the risk level

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for each requirement category. See Tracy, ¶0069, ¶0070. Then, at 110, documentation can be printed that includes information pertaining to the first five elements that would enable an accreditation decision (manual or automated) to be made based on the inputs and outputs respectively provided and generated in steps 100, 102, 104, 106, and/or 108. See Tracy, ¶0070.

For at least the following reasons, Tracy does not anticipate claim 1 under 35 U.S.C. § 102.

Applicants note that, based on the sections of Tracy cited in the rejection, it is clear that the Action is not analyzing the claim as a whole (see M.P.E.P. § 2106 (II)(C), stating that claims "must be considered as a whole."). The Action inconsistently applies Tracy to reject various elements of claim 1 and impermissibly dissects and isolates the claim elements recited in claim 1 without regard to the relationships specified in the claim. Specifically, the Action fails to consider the relationship between the claimed "quantifying each of the risks with a risk value" (emphasis added) and the claimed "defining a test plan for the process, the test plan including a number of test cases, wherein testing of the test cases is prioritized based on the risk value" (emphasis added) recited in claim 1.

To reject the claimed "quantifying each of the risks with a risk value," the Action cites ¶ 0070 of Tracy. See Action, page 2. Referring to the flow diagram depicted in FIG. 1, Tracy discloses that estimates of a risk level are output by a risk assessment in 108. See Tracy, ¶0070. To reject the claimed "defining a test plan for the process, the test plan including a number of test cases, wherein testing of the test cases is prioritized based on the risk value," the Action relies on the test procedures disclosed in ¶0076 of Tracy. In this paragraph, Tracy discloses that:

> Presentation manager 206 can also communicate with administration module 230 to, for example, update test procedures in knowledge base 228. Administrative module 230 facilitates communication between presentation manager 206 and persistence layer 218. Persistence layer 218 can be used, for example, to facilitate adding new requirements, editing existing requirements, adding a new test procedure and/or editing an existing test procedure to (or within) knowledge base 228. Persistence layer 218 can communicate with event module 214 which, in turn can, for example, notify react module 204 to alert an analyst that a new test is to be conducted.
> See Tracy, ¶0076.

Thus, the Action appears to argue that the testing of the test procedures described in ¶0076 of Tracy are prioritized by the estimates of a risk level output by a risk assessment in 108 from ¶0070. This assertion is wholly unsupported by Tracy.

Tracy does not disclose a relationship between the estimates of risk levels and a prioritization of test procedures similar to the priority relationship between the claimed risk values and the claimed test cases recited in claim 1. In fact, Tracy discloses that the estimates of the risk level are obtained after completion of the testing using the testing procedures. See Tracy, ¶0069, *stating* that "upon completion of testing, the *risk assessment* step . . . involves assessing for each requirement failure (should any exist) the vulnerability of the system, as well as the level of the threat as determined by the information gathered" (emphasis added).

The flow diagram in FIG. 21 of Tracy also clearly illustrates that the risk values are determined after completion of testing, and hence cannot be used to prioritize the testing of the test procedures. In 2104 of Tracy, test procedures are generated, and in 2106, the tests are executed. See Tracy, FIG. 21. Later, in 2114, the system calculates risks based on a "bucket risk formula." See Tracy, FIG. 21. Hence, the testing of the test procedures of Tracy cannot be prioritized based on risk level estimates because the risk level estimates are obtained after the test procedures are completed. By citing these paragraphs, it is apparent that the Action is not interpreting claim 1 as a whole. Rather, the Action impermissibly dissects various claim elements without regard to relationships defined in the claim.

Moreover, the Action has not shown that Tracy discloses "defining a test plan for the process, the test plan including a number of test cases, wherein testing of the test cases is *prioritized* based on the risk value" (emphasis added), as recited in claim 1. ¶ 0076 cited in the Action discloses test procedures, but does not disclose that the testing of the test procedures is prioritized based on a risk value, contrary to the statements made in the Action. Thus, the Action has not established that Tracy discloses each and every claim element in order to anticipate claim 1 under 35 U.S.C. § 102. Therefore, claim 1 is allowable over Tracy.

Additionally, it is noted that Tracy does disclose "a scheme whereby system vulnerabilities can be continuously assessed by considering newly discovered threats, and

updating testing requirements and procedures to account for such threats." See Tracy, ¶0069. However, this paragraph of Tracy does not disclose a priority relationship between the updated testing procedures and the estimates of the risk level. The updating disclosed in ¶0069 of Tracy is based on newly discovered threats, and is not based on prioritizing testing of the updated testing procedures based on the estimates of the risk level.

Accordingly, claim 1 is in condition for allowance and allowance thereof is respectfully requested. Claims 2-31 are also allowable for reasons analogous to those given in support of claim 1.

C.   RESPONSE TO THE REJECTION OF CLAIM 32 UNDER 35 U.S.C. § 102

The Action rejects claim 32 under 35 U.S.C. § 102 as allegedly being anticipated by Tracy. Applicants respectfully traverse this rejection.

Claim 32 recites:

> An article of manufacture comprising:
> a computer useable medium having computer readable program code means embodied therein for testing a process or a system, the computer readable program code means in said article of manufacture comprising:
> computer readable program code means for causing the computer to receive and store data identifying a plurality of risks associated with the process or system;
> computer readable program code means for causing the computer to receive and store a risk value associated with each of the plurality of risks;
> computer readable program code means for causing the computer to receive and store data defining a test plan for the process or system, the test plan including at least one test case, the at least one test case comprising at least one step;
> computer readable program code means for causing the computer to receive and store data associating each of the plurality of risks with a step of a test case; and
> computer readable program code means for causing the computer to generate a report listing the risks in order of the risk value.

For at least the following reasons, Tracy does not anticipate claim 32 under 35 U.S.C. § 102.

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Similar to the remarks provided above, the Action does not consider claim 32 as a whole and impermissible dissects claim elements without considering the relationships of the claim elements specified in the claim. Specifically, Tracy does not disclose the relationship between the claimed "computer readable program code means for causing the computer to receive and store a risk value associated with each of the plurality of risks" (emphasis added) and the claimed "computer readable program code means for causing the computer to generate a report listing the risks in *order* of the risk value" (emphasis added) recited in claim 32.

To reject the claimed storing of "a risk value associated with each of [a] plurality of risks," the Action relies on ¶0070 of Tracy, which discloses that estimates of a risk level are output by a risk assessment step 108 in the flow diagram of FIG. 1. To reject the claimed generating a "report listing the risks in order of the risk value," the Action relies on ¶0066, ¶0069, and ¶0070 of Tracy, which disclose that "documentation can be printed 110 that includes information pertaining to the first five elements that would enable an accreditation decision (manual or automated) to be made based on the inputs and outputs respectively provided and generated in steps 100, 102, 104, 106, and/or 108" (emphasis added). See Tracy, ¶0070.

However, Tracy does not disclose that the printed documentation including "the first five elements" lists the "first five elements" in order of the estimates of a risk level output by the risk assessment step 108 from the flow diagram of FIG. 1. Because the printed document of Tracy does not list the "first five elements" in the order of the estimates of a risk level, Tracy does not disclose "computer readable program code means for causing the computer to generate a report listing the risks in order of the risk value" (emphasis added), as recited in claim 32. Thus, the Action has not shown that Tracy anticipates claim 32 under 35 U.S.C. § 102. Therefore, claim 32 is allowable over Tracy and allowance thereof is respectfully requested.

Claims 33-35 also are in condition for allowance due to their dependence on claim 32 and allowance thereof is respectfully requested.

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CONCLUSION

For at least the reasons outlined above, Applicants respectfully assert that the applied art fails to fairly teach or suggest the claimed invention and that the application should therefore be allowed. Favorable reconsideration and allowance of the claims are respectfully solicited.

It is believed that no further fees are due in connection with this filing. However, if any fees are due, the Commissioner is hereby authorized to charge such fees (or credit overpayments) to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

HUNTON & WILLIAMS LLP

Dated: _Nov. 6, 2006_   By: _____
                                    James R. Miner
                                    Registration No. 40,444

HUNTON & WILLIAMS LLP
Intellectual Property Department
1900 K Street, N.W.
Suite 1200
Washington, DC 20006
(202) 955-1500 (telephone)
(202) 778-2201 (facsimile)

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